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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,847	02/07/2001	Hiroshi Takemoto	202198US-3DIV	3774

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EXAMINER

HARAN, JOHN T

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/04/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/777,847	TAKEMOTO ET AL.
	Examiner	Art Unit
	John T. Haran	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 September 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 32-34 is/are pending in the application.

4a) Of the above claim(s) 34 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 32 and 33 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 09/237,661.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5,7</u> .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 32 and 33 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the groups were not shown to be distinct and that there is no serious burden to search both groups. This is not found persuasive.

As noted in Paragraph 2, Paper no. 6 the process of claim 34, as claimed, can be practiced by another and materially different apparatus such as one that has a heating means rather than a photocuring means to cure the adhesive. An apparatus with a heating means and an apparatus with a photocuring means are materially different apparatus. Furthermore, another materially different apparatus for performing the process of claim 34, as claimed, includes an apparatus that has a light generator and light guide but no filter or an apparatus with just a light generator and no light guide or filter. In addition, the apparatus of claims 32 and 33, as claimed, can be used to practice another and materially different process such as photoactivating a cationic adhesive before it is applied to a substrate, or curing a coating on a substrate.

As noted in Paragraphs 3 and 4, of Paper no. 6, the restriction requirement is valid because the groups **require different searches and have divergent subject matter.**

Applicant argues that electronic searching allows all subclasses to be searched without any additional effort. Electronic searching via text searching loses its value unless the text search is narrow and limited. In the present instance claims 32 and 33

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are focused on an apparatus for photocuring adhesive that comprises a light generator, a light guide, and a filter wherein claim 34 is focused on a method for curing adhesive that allows an intermediate member to move due to shrinkage in the adhesive during curing. These are two totally divergent subject matters that would require separate electronic search strategies and it would be a serious burden to search both. Furthermore, claims 32 and 33 require substantial searching in classes 362, 392, and 313 not required for claim 34.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Gasser et al (U.S. Patent 5,154,791).

Gasser et al disclose a device for photocuring adhesive comprising a light generator such as a lamp to generate light used to cure an adhesive, a light guide configured to gather the generated light and direct along a path, and a filter located at the output of the light guide that filters out light under 400 nm (Column 7, lines 32-38 and 60-65). The device disclosed in Gasser et al is capable of fixing a part and a part support for mounting said part by use of photocuring adhesive, said part and said part support joined via an intermediate member formed of resin substantially transparent to

light. The filter of Gasser et al is configured to filter out light under 400 nm which serves the desired function of the filter of the present application (See Specification, page 43, lines 1-9). Gasser et al anticipate claim 32.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gasser et al (U.S. Patent 5,154,791) in view of Grimm (U.S. Patent 5,840,147).

Gasser et al are silent towards having a blower configured to send cooling air toward the material worked upon however, one of ordinary skill would have been motivated to have a blower to blow cooling air during radiation to reduce unwanted heating of the parts, as taught by Grimm (Figure 2; Column 6, lines 49-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made include a blower configured to send air toward the material worked upon in the device of Gasser et al in order to reduce unwanted heating.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al (U.S. Patent 5,904,795) in view of Grimm (U.S. Patent 5,840,147).

Murakami et al are directed to a device for fixing parts together with a photocurable adhesive comprising a light generator, such as a lamp, configured to

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generate light used to cure a photocuring adhesive and a filter located between the light generator and the material worked upon that is configured allow UV light to pass but block harmful infrared radiation that deforms the shape of the material worked upon from the excess heat generated from the infrared radiation (Column 10, lines 13-22). It is noted that the device of Murakami et al is capable of fixing a part and a part support for mounting said part by use of photocuring adhesive, said part and said part support joined via an intermediate member formed of resin substantially transparent to light.

Murakami et al are silent towards having a blower configured to send cooling air toward the material worked upon however, one of ordinary skill would have been motivated to have a blower to blow cooling air during radiation to reduce unwanted heating of the parts, as taught by Grimm (Figure 2; Column 6, lines 49-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a blower configured to send air toward the material worked upon in the device of Murakami et al in order to reduce unwanted heating.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is (703) 305-0052. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final
communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 308-
0661.

J. T. Haran

John T. Haran

October 29, 2002

John T. Haran
John T. Haran
October 29, 2002